



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Deniega et al.

) Group Art Unit: 3763

Appl. No. : 10/085,169

Filed : February 25, 2002

For : CATHETER FOR UNIFORM
DELIVERY OF MEDICATION

Examiner : Ann Y. Lam

AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed November 8, 2002, Applicants respectfully submit the following comments in connection with the above-captioned application. As a result of this amendment, Claims 1-6 remain pending. No pending claims have been amended and no new claims have been added.

Information Disclosure Statement

In the outstanding Office Action, the Examiner stated that the Information Disclosure Statement filed June 28, 2002 fails to comply with the provisions of 37 C.F.R. § 1.97, 1.98 and M.P.E.P. § 609 because copies of the foreign patent documents were not submitted. Applicants respectfully submit that copies of all of the foreign patent documents, with the exception of the EP 0 804 936 reference, were properly submitted in the Information Disclosure Statement filed

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October 19, 1999 in the prior application. Furthermore, the present application claims priority to the prior application and the prior application was referenced in the Information Disclosure Statement filed June 28, 2002. Thus, Applicants respectfully submit that the requirements of 37 C.F.R. § 1.98(d) have been satisfied and, therefore, copies of the foreign references (with the exception of EP 0 804 936) were not required to be submitted in the present application. However, for the sake of convenience, copies of the foreign references are also submitted herewith.

Applicants acknowledge that the EP 0 804 936 reference was not submitted in the prior application, because it was discovered after issuance of the prior application. Therefore, a copy of the EP 0 804 936 reference is being submitted in a supplemental Information Disclosure Statement filed herewith, along with the fee set forth in 37 C.F.R. § 1.17(p). Accordingly, Applicants respectfully request reconsideration of the present application in light of the foreign references not previously considered by the Examiner.

Acknowledgment Of Claim For Priority Under 35 U.S.C. § 120 Is Requested

With respect to the present application, Applicants have complied with all of the requirements of 35 U.S.C. § 120 to benefit from an earlier filing date in the United States. Accordingly, acknowledgement of the claim for priority, as set forth in the first sentence of the present specification, is respectfully requested.

Mottola et al. Is Not Prior Art To Pending Claims Of The Present Application

Claims 1-6 presently stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,957,901 to Mottola et al. Applicants respectfully submit that Mottola et al. is not prior art

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under 35 U.S.C. § 102(b) to the pending claims and request reconsideration and withdrawal of the present rejection.

As indicated above, Applicants have properly claimed priority to an earlier-filed U.S. Patent Application. Specifically, the present application is a divisional of U.S. Patent Application No. 09/363,228, filed July 19, 1999, now U.S. Patent No. 6,350,253. Accordingly, the present application is entitled to an effective filing date of July 19, 1999.

The Mottola et al. reference issued on September 28, 1999, which is after the effective filing date of the present application. Therefore, the Mottola et al. reference was not published *more than one year prior to* the effective filing date of the present application as is required by 35 U.S.C. § 102(b). Accordingly, rejection of Claims 1-6 by the Mottola et al. reference is improper and withdrawal of the present rejection is respectfully requested.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejection set forth in the outstanding Office Action are inapplicable to the present claims and specification. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

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The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Curtiss C. Dosier at (949) 721-7613 (direct line), to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 7, 2003

By: 

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